

To: Jill M. Pietrini(TrademarksCC@sheppardmullin.com)
Subject: U.S. Trademark Application Serial No. 88594690 - SHELBY RANCH - 44LB-293853
Sent: July 15, 2021 05:49:06 PM EDT
Sent As: tmng.notices@uspto.gov

Attachments

**United States Patent and Trademark Office (USPTO)
Office Action (Official Letter) About Applicant's Trademark Application**

U.S. Application Serial No. 88594690

Mark: SHELBY RANCH

Correspondence Address:

Jill M. Pietrini
SHEPPARD MULLIN RICHTER & HAMPTON LLP
1901 AVENUE OF THE STARS, SUITE 1600
LOS ANGELES CA 90067 UNITED STATES

Applicant: Shelby Ranch LLC

Reference/Docket No. 44LB-293853

Correspondence Email Address: TrademarksCC@sheppardmullin.com

NONFINAL OFFICE ACTION

The USPTO must receive applicant's response to this letter within six months of the issue date below or the application will be [abandoned](#). Respond using the Trademark Electronic Application System (TEAS). A link to the appropriate TEAS response form appears at the end of this Office action.

Issue date: July 15, 2021

The Office has reassigned this application to the undersigned trademark examining attorney.

This Office action is in response to applicant's communications filed on March 1 and 2, 2021. This Office action is supplemental to and supersedes the previous Office action issued on August 27, 2020 in connection with this application. Based on information and/or documentation in applicant's

response, the trademark examining attorney now issues the following new requirement for information about the goods. *See* TMEP §§706, 711.02.

Additionally, the previously-assigned trademark examining attorney inadvertently omitted a refusal of registration relevant to the mark in the subject application. *See* TMEP §§706, 711.02. Specifically, the specimen provided for the portion of the identified goods based on Section 1(a) is not acceptable. The trademark examining attorney apologizes for any inconvenience caused by the delay in raising this issue.

In the previous Aug. 27 Office action, the trademark examining attorney refused registration of the applied-for mark based on unlawful use under the Food, Drug, and Cosmetic Act and Trademark Act Section 2(e)(4) because the mark is merely a surname. In addition, applicant was required to amend the identification of goods and disclaim descriptive wording in the mark.

Based on applicant's response, the trademark examining attorney notes that applicant has provided the disclaimer and amended the identification. *See* TMEP §713.02. The applicant's arguments have also overcome the surname refusal, which is now withdrawn. *See id*

Summary of Issues:

- NEW ISSUE: Specimen Does Not Show Use in Commerce
- NEW ISSUE: Information About Goods Required

Specimen Does Not Show Use in Commerce

The application identifies a Section 1(a) use in commerce filing basis for the following goods: "Livestock; hay; chopped straw for animal bedding; straw mulch; natural recycled wood fiber for use as a ground cover; living plants" in class 31.

Registration for these goods is refused because the specimen appears to be mere advertising and does not properly show the applied-for mark as actually used in commerce. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.04(b), 904.07(a). An application based on Trademark Act Section 1(a) must include a specimen showing the applied-for mark as actually used in commerce for each international class of goods identified in the application or amendment to allege use. 15 U.S.C. §1051(a)(1); 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a).

Specifically, applicant submitted a specimen described as "marketing materials," which appears to contain a list of available goods and services and applicant's contact information.

Advertising is not acceptable as a specimen for goods. *See In re Yarnell Ice Cream, LLC*, 2019 USPQ2d 265039, at *15-16 (TTAB 2019) (quoting *In re Siny Corp.*, 920 F.3d 1331, 1336, 2019 USPQ2d 127099, at *2-3 (Fed. Cir. 2019)); *see also Avakoff v. S. Pac. Co.*, 765 F.2d 1097, 1098, 226 USPQ 435, 436 (Fed. Cir. 1985); TMEP §904.04(b), (c). Advertising includes online advertising banners appearing on search-engine results pages or in social media, advertising circulars and brochures, price lists, and business cards. *See* TMEP §904.04(b).

Specimens for goods include photographs of (1) the actual goods bearing the mark; (2) an actual container, packaging, tag or label for the goods bearing the mark; or (3) a point-of-sale display showing

the mark directly associated with the goods. *See* 37 C.F.R. §2.56(b)(1), (c); TMEP §904.03(a)-(m). A webpage specimen submitted as a display associated with the goods must show the mark in association with a picture or textual description of the goods and include information necessary for ordering the goods. TMEP §904.03(i); *see* 37 C.F.R. §2.56(b)(1), (c). Any webpage printout or screenshot submitted as a specimen must include the webpage's URL and the date it was accessed or printed on the specimen itself, within the TEAS form that submits the specimen, or in a verified statement under 37 C.F.R. §2.20 or 28 U.S.C. §1746 in a later-filed response. *See* 37 C.F.R. §2.56(c); TMEP §§904.03(i), 1301.04(a).

Applicant may respond to this refusal by satisfying one of the following for each applicable international class:

1. Submit a different specimen (a verified [“substitute” specimen](#)) that (a) was in actual use in commerce at least as early as the filing date of the application and (b) shows the mark in actual use in commerce for the goods identified in the application. A “verified substitute specimen” is a specimen that is accompanied by the following statement made in a signed affidavit or supported by a declaration under 37 C.F.R. §2.20: “The substitute specimen(s) was/were in use in commerce at least as early as the filing date of the application.” The substitute specimen cannot be accepted without this statement.
2. Amend the filing basis to [intent to use under Section 1\(b\)](#), for which no specimen is required before publication. This option will later necessitate additional fee(s) and filing requirements, including a specimen.

For an overview of the response options referenced above and instructions on how to satisfy these options using the online Trademark Electronic Application System (TEAS) form, see the [Specimen webpage](#).

Although applicant's mark has been refused registration, applicant may respond to the refusal by submitting evidence and arguments in support of registration. However, if applicant responds to the refusal, applicant must also respond to the requirement set forth below.

Information About Goods Required

To permit proper examination of the application, applicant must submit additional information about applicant's goods identified as "living plants." Because the application originally included hemp and CBD goods, the lawfulness of these "living plants" is not clear from the present record. *See* 37 C.F.R. §2.61(b); TMEP §§814, 1402.01(e).

The Agriculture Improvement Act of 2018 (2018 Farm Bill) authorized the production of hemp in the United States and directed the U.S. Department of Agriculture (USDA) to establish a new regulatory program for domestic hemp production. On October 31, 2019, the USDA published an interim final rule that establishes rules and regulations concerning the production of hemp. *See* Establishment of a Domestic Hemp Production Program, 84 Fed. Reg. 58,522 (October 31, 2019) (to be codified at 7 CFR pt. 390). Under the interim final rule, a producer must be licensed and/or authorized to produce hemp under a USDA approved plan. USDA approved plans include those plans submitted by States or Indian Tribes that have been approved by the USDA, or the USDA established Federal plan for producers in States and territories of Indian Tribes not covered by approved plans. Please note, however, that hemp farming and cultivation currently remains illegal in Idaho, Mississippi, and South Dakota.

The applicant must provide written responses to the following questions:

1. Are applicant's identified plants a strain of Cannabis Sativa L or a part of the Cannabis Sativa L plant (also known as cannabis, marijuana, or hemp) containing a THC content of more than 0.3 percent on a dry weight basis? If applicant has any documentation relative to the THC content of the goods, please submit them with the response. Otherwise, please provide information on the type of plants and/or flowers applicant offers/will offer under the trademark.
2. Will applicant's identified plants be planted for personal use?
3. Will applicant's identified plants be sold and/or provided to third parties through interstate commerce?
4. Is the applicant a pilot participant under the Agricultural Act of 2014? If yes, please provide supporting documentation.
5. Is the applicant currently an authorized hemp producer under a State, Tribal, or USDA Federal plan? If "yes," please specify which plan (State, including identifying which State, Tribal, or USDA), and provide the authorization or license number and any supporting documentation. If not currently an authorized hemp producer, please indicate applicant's intention and activities to secure authorization.
6. Will applicant's identified plants be grown/produced in the state of Idaho, Mississippi, or South Dakota?
7. To the applicant's knowledge and belief, has the wording SHELBY or SHELBY RANCH ever been used, or is intended to be used, as a varietal or cultivar (also known as strain) name?
8. To the applicant's knowledge and belief, has the wording SHELBY or SHELBY RANCH ever been used, or is it intended to be used, in connection with a plant patent, utility patent, or certificate for plant-variety protection?

Factual information about the goods must make clear how they operate, salient features, and prospective customers and channels of trade. Factual information about the services must clearly indicate what the services are and how they are rendered, their salient features, and their prospective customers and channels of trade. Conclusory statements regarding the services will not satisfy this requirement for information. Applicant has a duty to participate in the examination process by responding directly and completely to each request for information. *Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 1284-1285, 73 USPQ2d 1409, 1415 (Fed. Cir. 2005) ("So long as there is some legitimate reason for seeking the information . . . the applicant has a duty to respond.")

Failure to comply with a request for information is grounds for refusing registration. *In re Harley*, 119 USPQ2d 1755, 1757-58 (TTAB 2016); TMEP §814. Merely stating that information about the goods and services is available on applicant's website is an insufficient response and will not make the relevant information of record. *See In re Planalytics, Inc.*, 70 USPQ2d 1453, 1457-58 (TTAB 2004).

Advisory - Responding to a Non-Final Office Action

For this application to proceed, applicant must explicitly address each refusal and/or requirement in this Office action.

Please call or email the assigned trademark examining attorney with questions about this Office action. Although an examining attorney cannot provide legal advice, the examining attorney can provide additional explanation about the refusal(s) and/or requirement(s) in this Office action. *See* TMEP §§705.02, 709.06. The USPTO does not accept emails as responses to Office actions; however, emails can be used for informal communications and are included in the application record. *See* 37 C.F.R. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05.

[Click to file a response to this nonfinal Office action.](#)

/Sara Anne Helmers/
Sara Helmers (she/her)
Trademark Examining Attorney
Law Office 130
(571) 270-3639
sara.helmers@uspto.gov

RESPONSE GUIDANCE

- **Missing the response deadline to this letter will cause the application to [abandon](#).** The response must be received by the USPTO before midnight **Eastern Time** of the last day of the response period. TEAS maintenance or [unforeseen circumstances](#) could affect an applicant's ability to timely respond.
- **[Responses signed by an unauthorized party](#)** are not accepted and can **cause the application to [abandon](#)**. If applicant does not have an attorney, the response must be signed by the individual applicant, all joint applicants, or someone with [legal authority to bind a juristic applicant](#). If applicant has an attorney, the response must be signed by the attorney.
- If needed, **find [contact information for the supervisor](#)** of the office or unit listed in the signature block.

United States Patent and Trademark Office (USPTO)

USPTO OFFICIAL NOTICE

Office Action (Official Letter) has issued
on July 15, 2021 for
U.S. Trademark Application Serial No. 88594690

Your trademark application has been reviewed by a trademark examining attorney. As part of that review, the assigned attorney has issued an official letter that you must respond to by the specified deadline or your application will be [abandoned](#). Please follow the steps below.

- (1) [Read the official letter](#).
- (2) **Direct questions** about the contents of the Office action to the assigned attorney below.

Sara Helmers
Examining Attorney
LAW OFFICE 130
(571) 270-3639
Sara.Helmers@USPTO.GOV

Direct questions about navigating USPTO electronic forms, the USPTO [website](#), the application process, the status of your application, and/or whether there are outstanding deadlines or documents related to your file to the [Trademark Assistance Center \(TAC\)](#).

- (3) **Respond within 6 months** (or earlier, if required in the Office action) from July 15, 2021, using the Trademark Electronic Application System (TEAS). The response must be received by the USPTO before midnight **Eastern Time** of the last day of the response period. See the Office action for more information about how to respond.

GENERAL GUIDANCE

- [Check the status of your application periodically](#) in the [Trademark Status & Document Retrieval \(TSDR\) database](#) to avoid missing critical deadlines.
- [Update your correspondence email address](#), if needed, to ensure you receive important USPTO notices about your application.
- [Beware of misleading notices sent by private companies about your application.](#)

Private companies **not** associated with the USPTO often use public information provided in USPTO trademark applications to mail and email trademark-related offers and notices - most of which require fees. These companies often have names similar to the USPTO. All **official USPTO correspondence** will only be **emailed from the domain "@uspto.gov"**.